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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,929	11/20/2001	David P. Kowal	19538-06497	2211

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EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/989,929	KOWAL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel L. Greene	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 10, 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see REMARKS, filed 4/22/2005, with respect to 35 U.S.C. &120, has been fully considered and is persuasive. The not granting of the priority date has been withdrawn.

### ***Claim Rejections - 35 USC §101***

The claims as presently stated and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-7, 9-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, receiving a request for a resource for the specific property for a customer; and valuing the customer based at least on activities of the customer at two or more properties, where the customer value is specific to the property can be, as presented, done manually without the use of any technology.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, the Applicant recites a computer-implemented method in the preamble and does not incorporate it into the claims.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

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In the present case, the Applicant is valuing the customer with no apparent useful, concrete or tangible results.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant submits the limitations of determining a theoretical win and daily profits for the customer without providing how these are determined in the specifications.

4. Also, the limitation of determining a customer segment is not described in the specifications as to what variables are used for such determination. The Specifications appear to not provide the information necessary to enable such a determination.

5. Claims 11 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant submits the limitation of determining a default theoretical win for the customer without providing how it is determined in the specifications.

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6. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant submits the limitations of determining an actual theoretical win for the customer without providing how it is determined in the specifications.

7. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant submits the limitation of using a default "source" theoretical win value for the customer without providing how it is determined in the specifications.

**8. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claim 3, 4, 11, and 12, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Specifications do not appear to provide the information necessary for a person having ordinary skill in the art to which the invention pertains would have known how to determine the theoretical win, daily profits, customer segments, a default theoretical win, and an actual theoretical win.

**10. Allowable Subject Matter**

- a. Claims 5, 6, 7, 9, 10, 13 are objected to as being dependent upon a rejected independent claim, but would be allowable if rewritten in independent form including all of the limitations of the independent, any intervening claims and to include an amendment that overcomes the 101 rejections.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1, 2, 4, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over PROGRAMMED FOR PERFECTION-(frequent guest programs)(Focus on Hotels special issue)- Ylinen, Jerry-Travel Weekly, v47, n38, p26(3)-April 30, 1988 [Programmed], and further in view of CASINO DATA SYSTEMS-Going Public the IPO Reporter, v17, n13, pN/A- March 29, 1993. [Casino]**

As per claims 1 and 17:

Programmed discloses:

receiving a request for a resource for the specific property for a customer; pg. 1, Para. 8. Programmed teaches about members of a frequent guest program checking into participating properties. pg. 1, Para. 8. and

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valuing the customer based at least on activities of the customer at two or more properties, where the customer value is specific to the property. pg. 2, Para. 10.

Programmed teaches about different establishments, i.e. Radisson Hotels, Ramada Hotel Group, etc. having a mainframe that service participating properties that track number of stays, spending levels, length of stay and other pertinent details of the frequent traveler to match a specific product with a specific customer. Page 1. Para. 5.

Programmed discloses the claimed invention except for where the customer value is specific to the property. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to where the customer value is specific to the property since it is known in the art that when a customer checks in at an establishment, the customer value is specific to the property they are checking into.

Further, Casino teaches about where the customer value is specific to the property by providing incentives to individual players based on their level, frequency and time of play at the casino. pg. 1, Para. 1.

As per claim 2:

Programmed discloses the claimed invention except for wherein the customer activities are located at properties different from the property for which the customer is being valued.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein the customer activities are located at properties different from the property for which the customer is being valued since it is known in



the art that the frequent flyer and the frequent guest programs are run from a central mainframe to track the activities of customers throughout the industries/business points of service.

As per claim 4:

Programmed further discloses:

determining whether the customer should be incentivized. pg. 2, Para. 9.

As per claim 16:

Programmed further discloses:

wherein valuing the customer uses data based on the customer's previous trips to hotels only. pg. 1, Para. 9.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9497 (toll-free).

  
JAMES P. TRAMMELL  
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Daniel L. Greene  
Examiner  
Art Unit 3621

6/16/2005